

In re Appln. of Crystal et al.
Application No. 09/629,074

REMARKS

The Present Invention

The invention is drawn to a method of enhancing bone density or formation (claims 1-12, 17, 18, and 36), an adenoviral vector (claims 19, 21, 26, and 37-43), and a bone graft (claims 22-23, 25, and 27-33). Claims 1-12, 17-19, 21-23, 25-33, and 36-43 are pending.

Discussion of Claim Amendments

Claims 1-3, 6, 19, 26, and 37-43 have been amended to point out more particularly and claim more distinctly the present invention. Claims 1 and 6 have been amended to recite that the at least one first cell and the at least one second cell are within the bone or within a tissue immediately surrounding the bone. Claims 1 and 6, as well as claims 2, 3, 19, 26, and 37-43, have been amended to recite an adenoviral vector. The amendments to claims 1-3, 6, 19, 26, and 37-43 are supported by the specification at, for example, page 2, lines 17-33, page 4, lines 20-30, page 5, line 28, through page 7, line 15, and the Example, as well as the originally filed claims. Claims 20, 34, and 35 have been cancelled. No new matter has been added by way of these amendments.

The Advisory Action and Final Office Action

The Advisory Action states that the amendments set forth in the Response to Office Action dated May 12, 2003, would not be entered in that the proposed amendments would allegedly require new grounds of rejection under 35 U.S.C. § 112, second paragraph, with respect to claims 2 and 3. Claims 2 and 3 have been amended in an attempt to advance prosecution of the instant application to recite "the adenoviral vector." The remaining amendments to the claims set forth in the Response to Office Action dated May 12, 2003, as well as the Remarks presented therein, are set forth herein.

In the final Office Action of March 11, 2003, the Office rejected claims 1-12, 17-21, 26, and 34-43 under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. Reconsideration of the rejection is hereby requested. The final Office Action acknowledges that claims 22, 23, 25, and 27-33 are drawn to allowable subject matter.

Discussion of the Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-12, 17-21, 26, and 34-43 have been rejected under Section 112, first paragraph, for alleged lack of enablement. The Office Action concedes that the specification is enabling for administering either (i) an adenoviral vector encoding VEGF operably linked to a promoter or (ii) an adenoviral vector encoding VEGF and a second osteogenic protein

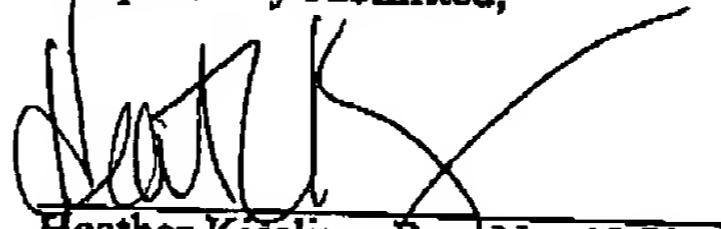
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each of which is operably linked to a promoter, to a bone or within a tissue immediately surrounding the bone, whereby bone density or formation is enhanced (page 2, last paragraph). Solely in an effort to advance prosecution of the instant application and not in acquiescence of the rejection, claims 1-3, 6, 19, 26, and 37-43 have been amended to recite an adenoviral vector and to recite that the first and second cells are within the bone or tissue immediately surrounding the bone. Thus, the rejection of claims 1-12, 17-21, 26, and 34-43 under Section 112, first paragraph, is moot.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



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Date: July 16, 2003